

REMARKS

Applicants express appreciation for the attention accorded the present Application in the July 1, 2004, Office Action. In the July 1, 2004, Office Action, Claims 1-23 was pending for consideration. Claims 1, 2, 5-16, 21-23 were rejected under one or more statutory grounds and Claims 3, 4, and 17-20 were objected to. The examiner has made the July 1, 2004, Office Action final. Accordingly, Applicants timely submit this office action and reconsideration of all claims in light of the following remarks is respectfully requested.

In consideration of Examiners remarks concerning the previous office action, Applicants point to the language in the Application, page 8 lines 4-6, "Optionally, the step of characterizing any whisker-like metallic particulates confirmed to be present for geometry..." Given the language of this section and the present amendment, the present invention is patently different than examples disclosed in the background section (i.e. wet wipe and/or swatch) of the present Application. The present invention discloses a method for sampling for a presence of fragile whisker-like metallic particulates in a data center by providing a tool capable of capturing and retaining the whisker-like metallic particulates in the fragile condition including a whisker-like geometry, and extracting from the surface any whisker-like metallic particulates present in substantially their fragile condition in a manner enabling characterization of the whisker-like geometry. A wet wipe and/or swatch is unable to retain or extract from a surface the whisker-like metallic particulates present in substantially their fragile condition in a manner enabling characterization of the whisker-like geometry.

Furthermore, Applicants respectfully disagree with the Examiner concerning the meaning of the word adhesive as applied in the present application. Applicants provide that the meaning of the term "adhesive" has been defined in the specification to include any material that provides more adhesive strength than the adhesion provided by water on a cloth or paper material (such as with a wet wipe), and are preferably substantially more adhesive. Applicants are permitted to be his or her own lexicographer as long as the meaning assigned to the term is not repugnant to the term's well known usage. *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure

from common usage would be so understood by a person of experience in the filed of the invention.” *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). Therefore, Applicants respectfully disagree with Examiner’s characterization and giving the word “adhesive” a broader meaning which was not intended by the Applicants.

Claim Rejections - 35 U.S.C. § 102

Before discussing the above rejections, it is thought proper to briefly state what is required to sustain such rejections. It is well settled that “[a] claim is anticipated only if each and every element as set forth in the Claims is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). In order to establish anticipation under 35 U.S.C. § 102, all elements of the claim must be found in a single reference. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 U.S.P.Q. 81, 90 (Fed. Cir. 1986), cert. denied 107 S.Ct. 1606 (1987). In particular, as pointed out by the court in *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1981), cert denied, 469 U.S. 851 (1984), “anticipation requires that each and every element of the claimed invention be disclosed in a prior art reference.” “The identical invention must be shown in as complete detail as is contained in the...claim.” *Richardson v. Suzuki Motor Co.* 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Claim Rejections - 35 U.S.C. § 102(a)

Claims 1, 2, 5-8, 11, 13-16, 21 and 22 were rejected under § 102(a), as being anticipated by the background section. Specifically, Examiner points to the statement in the background section which describes a method of sampling a given area for zinc particulates. The example includes a “wet wipe” swatch which is wiped across a given area to gather particulates. The wipe can then be sealed in a plastic bag and sent to a lab where tests are conducted to determine whether zinc is in the form of a zinc whisker. The current invention resolves any issues of sampling by providing a method of sampling for a presence of fragile whisker-like metallic

particulates in a data center by providing a tool capable of capturing and retaining the whisker-like metallic particulates in their fragile condition including a whisker-like geometry, locating a surface of the data center where metallic particulates may be present, extracting from the surface any whisker-like metallic particulates present in substantially their fragile condition in a manner enabling characterization of the whisker-like geometry. Accordingly, the method cited by the Examiner is not capable extracting from the surface any whisker-like metallic particulates present in substantially their fragile condition in a manner enabling characterization of the whisker-like geometry because the art of “wiping” will fracture the delicate whisker, destroying its whisker-like geometry. As such, the present invention is not anticipated by the cited reference.

Applicants respectfully submits Claims 1, 2, 5-8, 11, 13-16, 21 and 22 are not anticipated by the example stated in the background section. Claims 1, 2, 5-8, 11, 13-16, 21 and 22 are drawn towards a method capable of capturing and extracting from the surface any whisker-like metallic particulates present in substantially their fragile condition in a manner enabling characterization of the whisker-like geometry. As above mentioned, Applicants submit a wet wipe and/or swatch is unable to extract from the surface any whisker-like metallic particulates present in substantially their fragile condition in a manner enabling characterization of the whisker-like geometry. Specifically, a wet wipe is used by adding pressure wiping the wet wipe across a surface, the wiping motion of a wet wipe makes it impossible to extract the whisker-like metallic particulates in a state which enables for characterization of the whisker-like geometry. Accordingly, Applicants respectfully submit that the present invention is not anticipated by the cited section because the background section lacks the disclosure of each and every element of the claimed invention and request that the rejection be withdrawn.

As to Claims 1, 11, 13, 15, 16, and 21, Examiner suggests that the suspect areas being sampled are located as claimed. However, the Applicants submit that the reference does not teach each and every element of the presently claimed invention. For example, the cited section does not teach a method capable of extracting any whisker-like metallic particulates present in substantially their fragile condition in a manner enabling characterization of the whisker-like

geometry from a sample area. Therefore, every element of the present invention is not disclosed. Thus, the present invention is not anticipated by the description in the cited section.

As to Claims 2, 15, 16, and 21, Examiner submits that the particulates being sampled adhere to the wet wipe. As stated above, Applicants submit that a wet wipe is unable to extract from the surface any whisker-like metallic particulates present in substantially their fragile condition in a manner enabling characterization of the whisker-like geometry, which is accomplished by the present invention. In addition, Applicants submit that specification clearly suggests “Adhesive” shall include any material that provides more adhesive strength than the adhesion provided by water on a cloth or paper material (such as with a wet wipe), and are preferably substantially more adhesive. Furthermore, Applicants have discussed above that they are permitted to be their own lexicographer. Therefore, a wet wipe and/or swatch is not intended to be encompassed within the scope of the present invention. Thus, the present invention is not anticipated by the cited reference.

As to Claim 5, as stated above, a swatch is not covered within the scope of the present invention. Furthermore, a swatch is not capable of retaining or extracting from the surface any whisker-like metallic particulates present in substantially their fragile condition in a manner enabling characterization of the whisker-like geometry. A swatch is rubbed along the surface, thus the preservation of the whisker-like metallic particulates present in substantially their fragile condition is destroyed making it impossible to enable characterization of the whisker-like geometry as claimed in the present invention. As such, the teaching of a swatch does not teach the presently claimed invention. Therefore, the rejections to claim 5 should be withdrawn.

As to Claim 6, Examiner submits that the background section describes sampling from “a given area” to determine “the concentration” of particulates, suggestive of determination of density. The background section, however, does not teach each and every element, such as, a method that is able to extract from the surface any whisker-like metallic particulates present in substantially their fragile condition in a manner enabling characterization of the whisker-like geometry. Therefore, the present invention can not be anticipated by the cited section. Furthermore, since Claim 6 is dependant on an allowable claim, the rejection is now moot.

As to Claim 8, Examiner submits the background section teaches of a “plastic bag” to protect sample from contamination. A plastic bag, however, is unable to preserve the whisker-like metallic particulates present in substantially their fragile condition in a manner to enable for characterization of the whisker-like geometry as taught by the presently claimed invention. Therefore, the present invention can not be anticipated by the cited section. Moreover, since Claim 8 is dependant on an allowable claim, the rejection is now moot.

As to Claim 14, Examiner submits potential sample areas include the bottom of floor tiles, as they are “dragged across the top of each other”, necessarily causing particulates on bottom surfaces. In addition, the step “dragging across the top of each other”, is unable to provide the whisker-like metallic particulates present in substantially their fragile condition in a manner to enable for characterization of the whisker-like geometry. Thus, the present invention is not anticipated by the cited reference. Furthermore, since Claim 14 is dependant on an allowable claim, the rejection is now moot.

As to Claim 22, Examiner suggests that identification is carried out by “visual inspection” in addition to the “wiping”. Claim 22 does not specifically claim a visual inspection to characterize the whisker-like metallic particulates. The invention according to Claim 22 can be carried out by many different methods, such as, electron microscope or other microscopic viewing devices. The visual inspection is unable to characterize the geometry of the whisker-like metallic particulates as claimed. Consequently, the presently claimed invention is not anticipated by the cited reference. Moreover, Claim 22 is dependant on an allowable claim and thus the rejection is now moot.

In view of above, each and every element of the claimed invention is not disclosed, thus Applicants submit that the remarks and amendments have overcome the rejections. Therefore, the Applicants respectfully requests that the rejections be withdrawn.

Claim Rejections - 35 U.S.C. § 103

Before discussing the rejection, it is thought proper to briefly state what is required to sustain such a rejection. The issue under § 103 is whether the PTO has stated a case of prima

facie obviousness. "The PTO has the burden under § 103 to establish a prima facie case of obviousness." In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). To satisfy this burden, the PTO must meet the criteria set out in M.P.E.P § 706.02(j):

. . . three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Moreover, the obviousness analysis must comply with the statutory scheme as explained by the Supreme Court in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966), namely, consideration must be given to: (1) the scope and content of the prior art, (2) the differences between the prior art and the claimed invention, (3) the level of ordinary skill in the pertinent art, and (4) additional evidence, which may serve as indicia of non-obviousness.

The following discussion of the cited references is currently focused on the lack of motivation to combine the cited references. Therefore, the following discussion of applicable case law is considered an important background for the Examiner to keep in mind during this discussion.

In order to maintain a prima facie case of obviousness by combining references, the prior art must provide some reason or motivation to make the claimed compositions. In re Dillon, 16 U.S.P.Q.2d 1897, 1901 (Fed. Cir. 1990). As aptly stated in *In re Jones*, 21 U.S.P.Q.2d 1941, 1943-44 (Fed. Cir. 1992):

"Before the PTO may combine the disclosure of two or more prior art references in order to establish prima facie obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art... Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill in the...art would have been motivated to make the modifications of the prior art necessary to arrive at the claimed (invention)."

An excellent summary of how the prior art must be considered to make a case of prima facie obviousness is contained in *In re Ehrreich et al.*, 220 U.S.P.Q. 504, 509-511 (CCPA 1979).

There the court states that a reference must not be considered in a vacuum, but against the background of the other references of record. It is stated that the question of a § 103 case is what the reference(s) would "collectively suggest" to one of ordinary skill in the art. However, the court specifically cautioned that the Examiner must consider the entirety of the disclosure made by the reference and avoid combining them indiscriminately.

In finding that the "subject matter as a whole" would not have been obvious in *Ehrreich* the court concluded:

"Thus, we are directed to no combination of prior art references which would have rendered the claimed subject matter as a whole obvious to one of ordinary skill in the art at the time the invention was made. The PTO has not shown the existence of all the claimed limitations in the prior art or any suggestion leading to their combination in the manner claimed by Applicants." (underlining added)

It has been widely recognized that virtually every invention is a combination of elements and that most, if not all, of these will be found somewhere in an examination of the prior art. This reasoning lead the court, in *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983) to state:

"...it is common to find elements or features somewhere in the prior art. Moreover, most if not all elements perform their ordained and expected function. The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made." (underlining added)

In re Sernaker, 217 U.S.P.Q. 1, 5-6, (Fed. Cir. 1983) states a test to determine whether a rejection of an invention based on a combination of prior art elements is appropriate as follows:

"The lesson of this case appears to be that prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings...The board never showed how the teaching of the prior art could be combined to make the invention." (underlining added)

Moreover, in *In re Dow Chemical Co.*, 5 U.S.P.Q.2d 1529, (Fed. Cir. 1988), the court states that both the suggestion and the expectation of success must be founded in the prior art, not in the applicants disclosure. The Federal Circuit stated in *In re Carroll*, 202 U.S.P.Q. 571, 572 (Fed. Cir. 1979):

One of the more difficult aspects of resolving questions of non-obviousness is the necessity "to guard against slipping into use of hindsight (citing *Graham v. Deere*). Many inventions may seem obvious to everyone after they have been made...(citation of §103)...Thus, in deciding the issue of obviousness, we must look at the prior art presented from a vantage point in time prior to when the invention was made, and through the eyes of a hypothetical person of ordinary skill in the art.

Claim Rejections - 35 U.S.C. § 103(a)

With the above citation in mind, Applicants contends that the Examiner has failed to meet the burden of making a prima facie case of obviousness.

Claims 7 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Statement. Because Claims 7 and 12 are dependent on allowable claims, Applicants respectfully submits that such rejection is moot and respectfully requests that the rejection be withdrawn.

Claims 8 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Statement as applied to claim 1 above, and further in view of Jezek.

Jezek teaches a sampling device to sample radioactive waste where the sample is collected and the pad and body are enclosed in a cap. The cap is designed to totally enclose and retain the pad and body of the sampling device. The reference, however, is devoid of teaching the presently claimed invention of protecting or preserving the whisker-like metallic particulates present in substantially their fragile condition in a manner to enable for characterization of the whisker-like geometry of the particulates from further contamination or storing whisker-like metallic particulates sample in a condition such that the adhesive portion does not contact the enclosure.

Jezek does not teach or suggest that the sampling device can be used for capturing or extracting from the surface any whisker-like metallic particulates present in substantially their

fragile condition in a manner enabling characterization of the whisker-like geometry. Therefore, it would not be obvious to one of ordinary skill in the art, to modify the reference or to combine the reference teachings.

Claim 23 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Statement as applied to claim 15 above, and further in view of Johnsson et al. However, Claim 23 is dependent on allowable claims, Applicants respectfully submits that such rejection is moot and respectfully requests that the rejection be withdrawn.

Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants' Statement as applied to claim 2 above, and further in view of Moos. However, Claim 10 is dependent on allowable claims, Applicants respectfully submits that such rejection is moot and respectfully requests that the rejection be withdrawn.

Applicants now submit that claims 1-23 are allowable and respectfully requests that all rejections be withdrawn.

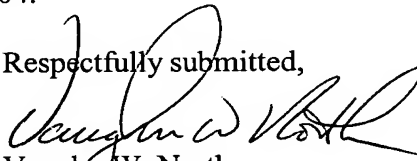
CONCLUSION

In view of the foregoing, Applicants believe that the present patent application is in condition for allowance. Therefore, Applicants respectfully request that the amendments and remarks be considered and the rejections be withdrawn. If any impediment to the allowance of these claims remains after entry of this Amendment, the Examiner is strongly encouraged to contact Vaughn North at (801) 566-6633 so that such matters may be resolved as expeditiously as possible.

The Commissioner is hereby authorized to charge any additional fee or to credit any overpayment in connection with this Amendment to Deposit Account No. 08-2025.

DATED this 1st day of December, 2004.

Respectfully submitted,



Vaughn W. North

Registration No. 27,930

THORPE, NORTH & WESTERN, L.L.P.

P.O. Box 1219

Sandy, Utah 84091-1219

Telephone: (801) 566-6633